



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,076	10/27/2000	Nicos A. Petasis	06666/005002	9032

7590

03/26/2003

Scott C. Harris
FISH & RICHARDSON P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,076

Applicant(s)

Petasis et al

Examiner

Maurie G. Baker

Art Unit

1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 25, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 18-21, 29, and 34-43 is/are pending in the application.
- 4a) Of the above, claim(s) 34 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 18-21, 29, 35-39, and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to Art Unit 1639.

1. Applicant's Response filed November 25, 2002 (Paper No. 10) is acknowledged. Claims 36 and 37 were amended, and no claims were added or cancelled in Paper No. 10. Therefore, claims 12, 18-21, 29 and 34-43 are currently pending.

Election/Restriction

2. Applicant's election of Group I (originally claim 12), without traverse, in Paper No. 6 is noted. The election of species in Papers No. 10 and 8 is also noted. Based on the claim amendments in these papers and the explanation in Paper No. 10, the election is now considered responsive for the sake of compact prosecution *only*. Please see examiner's comments below.

3. It is noted for the record that applicant's election still is extremely confusing. Applicant states in Paper No. 10 (pages 2-3) that "claim 38 is generic to the elected species" but also that the library includes "at least the compounds prepared in Examples 1, 2, 3, 6, 8, 9, 10, 11, 12, 14, 15, 18, 22, 23, 24 and 25". These examples are of single compounds, not libraries. Moreover, only one of these Examples (i.e. Ex. 9) reads on the formula in instant claim 38 (which *requires* compounds of formula 23 where R⁹, R¹⁰ and R¹¹ are non-hydrogen). Many of these Examples do not contain unsaturated compounds at all (i.e. Ex. 10, 11, 12, 14, 15, 19 and 24). Since applicant states that "claim 38 is

generic to the elected species”, the examiner has examined the claims to the extent of the elected species (formula 23) only.

4. Claims 34, 40, 41 and 42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, there being no allowable generic or linking claim.

5. Claims 12, 18-21, 29, 35-39 and 43 read on the elected species and are examined on the merits in this action. Also see paragraph 3 above.

6. Applicant’s specifically elected species was searched and was found in the prior art. Thus, the search was *not* expanded to non-elected species. See MPEP § 803.02.

Information Disclosure Statement

7. The Information Disclosure Statement (PTO-1449) filed June 1, 2001 is acknowledged; however, the IDS has not been considered as the parent case (08/884,188) in which the references are located is not currently available to the examiner. The examiner is making efforts to locate these references; however, resubmission of these documents, if possible, by applicant would facilitate their consideration and would be greatly appreciated by the examiner. A signed copy of the PTO-1449 will be mailed as soon as the examiner obtains copies of the references.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 12, 18-21, 29, 35-39 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not provide support for the invention as now claimed. To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. Applicant's claims are directed to a "combinatorial library" of various formulas. However, the instant description fails to support such combinatorial libraries. There are no examples of any combinatorial libraries whatsoever and only a vague showing that they were even contemplated in the generic sense (instant specification, page 7, lines 14-36). No support for the specifically claimed (i.e. by formula) libraries of claims 18-21 and 35-39 is present. Note that a broad generic disclosure is **not** sufficient support for a specific entity within the class.

The language of the specification should describe the claimed invention so that one skilled in the art can recognize what is claimed. The disclosure must

allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. *University of California v. Eli Lilly and Co.* (U.S. Court of Appeals Federal Circuit (CAFC) 43 USPQ2d 1398 7/22/1997 Decided July 22, 1997; No. 96-1175).

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 12, 18-21, 29, 35-39 and 43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palfreyman et al (US 4,421,767).

Palfreyman et al disclose collections of compounds (reading on the claimed “combinatorial library”) that read directly on the instant formulas 1 and 23. See, compounds of the formulas I, II and III in Palfreyman et al (columns 3-4). The compounds of the reference read on the claims where in the instant formula 23 R^1 & $R^2 = H$; $R^3 = H$; $R^9 = \text{aryl}$; and R^{10} & $R^{11} = \text{fluoro, chloro or bromo}$. The compounds of formulas I and II of Palfreyman et al also read on the instant formulas 1 and 4. The collections of compounds of the reference reads on applicant’s definition of a “combinatorial library” (see, instant specification, page 7, lines 14-36).

In the alternative, although Palfreyman et al does not disclose that their collections of compounds (i.e. libraries) are made by the claimed processes, the products of Palfreyman et al would appear to be the same as those recited by the instant claim, regardless of their method of manufacture. See MPEP 2113. Also note that many of the instant claims recite process limitations only and thus are non-limiting on the product.

The collection of compounds of Palfreyman et al (reading on the claimed “combinatorial library”) meet all of the limitations of the claimed library except for the product-by-process limitations and would either anticipate or render obvious the claimed library. “[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The examiner respectfully points out that since the claim is drawn to a “combinatorial library”, but this product is defined as a product-by-process, that any collection of compounds meeting the structural requirements of the instant claims reads on this product. The process by which the claimed library is made does not appear to lend patentable weight to the claimed invention. One of ordinary skill would expect the library to be the same no matter how it was synthesized.


Status of Claims/Conclusion

14. No claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
March 21, 2003



MAURIE GARCIA BAKER PH.D
PRIMARY EXAMINER